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EXAMINER

KUGEL, TIMOTHY J

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

06/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1. Claims 3, 6, 7 and 9 are pending as amended on 17 June 2009, claims 1, 2, 4, 5 and 8 being cancelled.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.
3. Since the amendment filed 17 June 2009 raises no new issue that would require further consideration or search and does not raise the issue of new matter, the amendment to the claims and applicant's remarks have been entered and fully considered.
4. Due to an inadvertent typographic error, claim 6 was listed in the rejection under 35 USC 102(b) as being anticipated by Japanese Patent Publication JP 2002-155197 (Tanide) when it should have been listed in the rejection under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being unpatentable over Tanide. The limitations of claim 6 were treated in both of the above rejections in the previous Office action.

Response to Amendment and Arguments

5. Applicant's cancellation of claims 1, 2, 4, 5 and 8 has rendered the following moot:

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The rejection of claims 1, 2 and 4 under 35 USC 102(b) as being anticipated by Japanese Patent Publication JP 2002-155197 (Tanide hereinafter) has been withdrawn.

The rejection of claims 5 and 8 under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being unpatentable over Tanide has been withdrawn.

6. Applicant's arguments have been fully considered but are not persuasive.

Applicant argues that the sheet of the instant claims is stretched as shown by the two conditions ΔH_m and ΔH_c and that the plastic body of Tanide, being sheet extrusion-molded or injection, vacuum or air-pressure formed is not stretched; however, the act of extrusion or injection, vacuum or air-pressure forming innately causes stretching of the sheet.

Applicant further argues that the heating recited in claim 3 is carried out to determine the ΔH_m and ΔH_c values of the sheet; but this is exactly the examiner's position, that the ΔH_m and ΔH_c values are properties of the sheet and therefore, since Tanide teaches the same composition as claimed, the properties of the composition must also be the same as claimed. "[A] compound and all of its properties are inseparable; they are one and the same thing." *In re Papesch*, 315 F2d 381, 391 (CCPA 1963). "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co v Ireco, Inc*, 190 F3d 1342, 1347 (Fed Cir 1999); see also *In re Omeprazole Patent Litigation v*

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Andrx Pharms, Inc, 483 F3d 1364, 1373 (Fed Cir 2007) ("The record shows [the claimed limitation] in the prior art even though that process was not recognized at the time. The new realization alone does not render that necessary prior art patentable."); *Schering Corp v Geneva Pharms*, 339 F3d 1373, 1377 (Fed Cir 2003) ("[I]nherent anticipation does not require that a person of ordinary skill in the art at the time would have recognized the inherent disclosure."). Further, the recitation of certain physical characteristics does not render patentable a claimed invention which is clearly obvious over a reference that is otherwise silent as to those characteristics. *In re Skoner*, 517 F2d 947, 950 (CCPA 1975) ("Appellants have chosen to describe their invention in terms of certain physical characteristics of the roughened substrate surface... Merely choosing to describe their invention in this manner does not render patentable their method.").

Information Disclosure Statement

7. It is noted that applicant has submitted an information disclosure statement including a reference cited on the information disclosure statement filed 22 December 2008, but not indicated by the examiner's initials as being considered. The examiner has initialed the reference on the information disclosure statement filed 17 June 2009 to indicate that the reference has been considered.

Claim Rejections - 35 USC § 102 and/or 35 USC § 103

8. Claims 3, 6, 7 and 9 stand rejected under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being unpatentable over Tanide.

Citations below come from a machine translation of Tanide, a copy of which is included with this action.

Tanide teaches a polylactic acid composition, sheet and articles formed from said sheet (0029), wherein said composition comprises 50-99.9 mass percent polylactic acid wherein polylactic acid of high crystallinity comprises at least 20% and preferably more than 50 mass percent and has an L-form to D-form ratio of not lower than 95:5 and not higher than 5:95 (Abstract and 0012) and wherein the polylactic acid may be copolymerized with other aliphatic polyester forming monomers—including hydroxybutyric acid as instantly exemplified (0009).

Pertaining specifically to claims 3, 6, 7 and 9, since Tanide teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the ΔH_m and ΔH_c —and therefore the relationships between the ΔH_m and ΔH_c —of the Tanide composition would inherently be the same as claimed. If there is any difference between the product of Tanide and the product of the instant claims the difference would have been minor and obvious.

Claims 7 and 9 are viewed as product-by-process claims and hence the methods they are created by are not pertinent, unless applicant can show a different product is produced. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability

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of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed Cir 1985).

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 USC 102 and 103. "There is nothing inconsistent in concurrent rejections for obviousness under 35 USC 103 and for anticipation under 35 USC 102." *In re Best*, 562 F.2d 1252, 1255 n4, 195 USPQ 430, 433 n4 (CCPA 1977).

Conclusion

9. The finality of the previous Office action is maintained.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is 571-272-1460. The examiner can normally be reached on 6:30 AM - 5:00 PM Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy J. Kugel/
Primary Examiner, Art Unit 1796